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In the

Supreme Court of the United States

OCTOBER TERM, [redacted] 1969

No. 22049

K-S-H PLASTICS, INC.,

Petitioner,

vs.

CAROLITE, INC. and
J. W. CARROLL & SONS,

Respondent.

No. 22049A

K-S-H PLASTICS, INC.,

Petitioner,

vs.

SUNBEAM LIGHTING COMPANY, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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The Scheffer Press, Inc.—ANdover 3-6850

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner, K-S-H Plastics, Inc. prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered in the above-entitled cases on February 26, 1969.

Citations to Opinion Below

The Findings of Fact, Conclusions of Law and Judgment Order of the District Court are unreported and appear in the certified record. The opinion of the Circuit Court of Appeals (Appendix, *infra,* pp. 1a-8a) is reported in 408 F.2d 54.

Jurisdiction

The judgments of the Court of Appeals for the Ninth Circuit were entered on February 26, 1969. (Appendix, *infra,* p. 9a) A petition for rehearing was denied on April 8, 1969. (Appendix, p. 10a) The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

Questions Presented

1. Since the *Sears* and *Compco* cases* permit a manufacturer to copy and sell products identical to unpatented goods sold by another with impunity, is there a heavy duty on such manufacturer to adopt marketing practices, such as use of trade symbols, trade names and identification of origin or source, that will avoid confusion in the trade and will prevent "distributors" from palming off such copies as products emanating from the originator?

2. Can trade symbols which are entirely arbitrary at the time of adoption become generic terms although only one manufacturer uses such symbols for a period of approximately two years?

3. Will similar trade symbols now being adopted become generic in the future merely by the act of another

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* *Sears, Roebuck & Co.* v. *Stiffel Company,* 376 U.S. 225 (1964); *Compco Corp.* v. *Day-Brite Lighting Inc.,* 376 U.S. 234 (1964).

manufacturer copying the original products and his use of confusingly similar marks.

Statute Involved

The statute involved is set forth in the Appendix, *infra*, p. 11a.

Statement

Only those facts in each of the cases will be presented that bear upon the question of duty to market indistinguishable products in appearance but not necessarily performance in a manner to protect the customer.

Plaintiff, K-S-H Plastics, Inc., brought this action for trademark infringement and unfair competition against Carolite, Inc. and J. W. Carroll & Sons (hereinafter referred to collectively as "Carolite"). Plaintiff and Carolite manufacture and sell plastic lighting lens panels used in fluorescent lighting fixtures. Sunbeam Lighting Company, Inc. (hereinafter referred to as "Sunbeam") is a manufacturer of lighting fixtures. The channel of distribution of lighting panels include the panel manufacturer, fixture manufacturer, electrical contractor, general contractor and building owner. (R. 17) The owner is represented by an architect or lighting engineer who prepares a written specification identifying the electrical equipment, including the lighting fixtures and panels, based on technical requirements. The fixture manufacturers (such as Sunbeam) prepare and submit bids based on these specifications. The owner, through the successful contractor, then awards the contract to the lighting fixture manufacturer. A purchase order is presented to a distributor which orders the fixture from the lighting fixture manufacturer. The fixture manufacturer orders the panels from suppliers such as K-S-H and Carolite where the

panels are so specified or obtains approval for a substitute made by another panel manufacturer.

When a lighting lens panel with a particular lighting performance and manufactured by K-S-H is specified, an identical panel in physical appearance may be obtained by a fixture manufacturer from Carolite and substituted without permission or knowledge of the architect or lighting engineer acting on the owner's behalf. This palming off by the fixture manufacturer is abetted by Carolite which does not identify its panels in a manner such that the architect can check to assure he received what he ordered. (R. 465-66)

Plaintiff has also identified its panels in the trade by the alphanumeric symbols K-4, K-5, K-11 and K-12, each of which is used in connection with a panel of particular lighting performance. Carolite sells identical panels in appearance with the same four configurations as does Plaintiff and identifies its panels as C-4, C-55, C-11 and C-12. (R. 42-43) Plaintiff uses the trademark K-LITE to identify its line of panels; J. W. Carroll & Sons used CAROLITE and later incorporated Carolite which continued the use. (R. 41) Carolite used the same embossing roll engraver which prepared the embossing tools *from Plaintiff's drawings and specifications and at Plaintiff's cost.* (R. 115, 391, 395)

Plaintiff abandoned use of the multi-page flyer it had previously used and began using a 3-ring notebook catalog divided into sections on each lens or panel which emphasized their technical performance. Carolite followed this new format. Plaintiff's numbers were in order of introductions of K-4, K-5, K-11 and K-12. K-4 was the earliest and K-12 the latest. These were filed in its catalog numerically. Defendants' products in order of introduction

were C-55, C-11, C-12 and C-4 but were placed in their catalog as C-4, C-55, C-11 and C-12 in a non-numeric order but one which followed Plaintiff's catalog. (Pl. Exs. 4 and 73; R. 92, 427, 429) K-S-H used a photometric testing laboratory to prove its panel performance and incorporated the test reports with some modifications, in its catalog. (Plf. Ex. 4; R. 94) Carolite later used the same laboratory and used the test reports in its similar catalog after making the same modifications (Plf. Ex. 73; R. 405)

Sunbeam admitted supplying Carolite panels to customers which ordered Plaintiff's panels by using the trade designation K-4, K-5, K-11 or K-12, without informing them of the substitution. (R. 605, 658-60, 691-92)

Reasons for Granting Writ

In *Sears, Roebuck & Co.* v. *Stiffel Company*, 376 U.S. 225 (1964) and *Compco Corp.* v. *Day-Brite Lighting Inc.*, 376 U.S. 234 (1964) this Court generally established the extent of federal pre-emption of state unfair competition law. Permitting copying of an unpatented and uncopyrighted product was found consistent with the general policy of free competition to which the patent monopoly was but an exception. While the Court recognized and implemented the salutary effect on the public of price competition between copiers and an orignator, it anticipated the potential dire consequences of unqualified approval of copying. Specifically, the Court pointed out that the States were free to continue to provide protection of the consuming public against deception and unfair marketing practices of copiers, as well as other manufacturers. Copying, while permissible and serving an important economic function, was not an activity to be rewarded by a mantle of immunity from laws applicable to more ordinary individuals.

Perhaps as an inescapable concomitant to a decision which substantially alters the path of the law, the limits of countenanced state activity were broadly stated with resulting widespread disaccord in interpretation by the courts below. In the *Sears* case, it was stated at page 232:

> "Doubtless a State may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source, just as it may protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods."

And in *Compco* it was declared at page 238:

> "As we have said in Sears, while the federal patent laws prevent a State from prohibiting the copying and selling of unpatented articles, they do not stand in the way of state law, statutory or decisional, which requires those who make and sell copies to take precautions to identify their products as their own. A State of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer's reputation for quality and integrity, deceive the public by palming off their copies as the original."

The requirement of labeling and the prohibition of "palming off" was clearly within the power of the states. But in light of the expected increase in copying which was not allowable, the unanswered question was whether prior state law as to labeling and palming off could be effective unless applied more stringently. In construing this Court's statements with regard to how the public may be adequately protected while copying proliferated,

the lower courts took disparate views as to their obligations.

In *Spangler Candy Company* v. *Crystal Pure Candy Company*, 353 F.2d 641 (7th Cir. 1965) the court denied relief where an article was copied and the defendant admittedly intended to simulate plaintiff's packaging, labels and trademarks. Actual confusion was found, but no secondary meaning of the trade dress or palming off. The lower court was affirmed because plaintiff failed to "meet the exacting tests laid down in the *Sears* and *Compco* cases." 353 F.2d at 648. The court appears to have withheld relief because of the lack of a pertinent labeling law in the state in which the action arose.

In *Flexitized, Inc.* v. *National Flexitized Corporation*, 335 F.2d 774 (2d Cir. 1964) the court found a federally registered trademark invalid on the ground of descriptiveness and lack of secondary meaning. The Court granted relief, notwithstanding the failure to establish secondary meaning, for misappropriation as that doctrine was established in *International News Service* v. *Associated Press*, 248 U.S. 215 (1918) and subsequent New York state decisional law. The *Sears* and *Compco* rule was said to only prohibit the states from granting "what is in effect patent protection." 335 F.2d at 781, n. 4.

In *Tappan Company* v. *General Motors Corporation*, 380 F.2d 888 (6th Cir. 1967) the court affirmed the lower court decision that there was no unfair competition by defendant's marketing of a simulated product and no violation of a labeling law or proved intent to deceive. In *Bentley* v. *Sunset House Distributing Corp.*, 359 F.2d 140 (9th Cir. 1966) it was held that the copier's use of its own name in marketing the simulated article precluded relief for unfair competition under the palming off doc-

trine. But palming off, arising from the natural and probable result of confusion because of packaging including similar trade symbols, was enjoined in *Plastics Research & Development Corp.* v. *Norman*, 243 Ark. 780, 422 S.W. 2d 121 (1967).

Numerous District Courts have also applied the *Sears* and *Compco* rule with varying degrees of stringency. See, Derenberg, *The Eighteenth Year of Administration of the Lanham Trademark Act of 1946*, 146 U.S.P.Q., No. 6, Part II, pp. 29-32 (1965). The cases reflect the judicial confusion as to whether: (1) labeling alone is always sufficient to protect the purchaser; (2) palming off may be proscribed if the packaging is confusingly similar; or (3) similar trade dress will be prohibited only if the dress has acquired secondary meaning.

In the present case, the lighting panels were supplied by Carolite to lighting fixture manufacturers that removed the panels from a marked container (although some containers were not marked), installed the panels in lighting fixtures and shipped the fixtures to the customer. *The panels were not marked, labeled or otherwise identified as to source.* The courts below found that the trade symbols K-4, K-5, K-11 and K-12 were not used primarily to indicate source but also designated the pattern on the panels. Yet this Court has held that where a copier has used any unfair means to pass its product off on the public as that of the originator, the *consumer* must be protected. *William R. Warner & Co.* v. *Eli Lilly & Co.*, 265 U.S. 615 (1924). In that case the plaintiff's trademark was found descriptive so that the defendant had a right to use a similar trade symbol. But the defendant was required to use a label on its products which warned the dealer not to sell the products in response to an order for

plaintiff's product. Thus, even though plaintiff's product was ordered by a trade symbol which was not a technical trademark, the symbol was sufficiently distinctive as an identification of plaintiff's goods to justify protection of the purchasers. In effect, this Court recognized that a copier's marketing practices must be particularly circumspect.

Carolite was similarly enjoined in this case but *only* when plaintiff's panels were ordered by the registered trademarks K-LITE or K-S-H. The clear rule of the *Warner* case was not applied, though the facts were startlingly similar. The lower courts considered the issue of palming off by mechanically first determining that plaintiff's trade symbols were not valid technical trademarks and then summarily deciding that no protection against palming off could be given because such trade symbols did not "primarily indicate origin" or "specifically" indicate a request for plaintiff's panels.

Petitioner submits that the consumer interest cannot be satisfied solely by availability of copied products made possible under the *Sears* and *Compco* rule. Protection must also be afforded by the rule in the *Eli Lilly* case. This requires that this Court further delineate the distinction between the right to copy and the right to market an identical product in an identical manner and trade off the goodwill established by the originator.

The increasing occurrence of sale of simulated goods demands that the courts more closely scrutinize the marketing practices of the copier to assure that the product and not the goodwill of the originator has been fairly appropriated. In the lower court cases discussed above, it is apparent that these courts have misunderstood the scope of the *Sears* and *Compco* rule. Rather than a more

searching examination of the marketing practices of the copier, these courts have read the *Sears* and *Compco* cases as providing license for unfairness and fraud. An uncompromising procrustean test for secondary meaning of trade symbols (even if correctly applied here) is seriously misplaced in a case where product simulation also occurs. The doctrine laid down in the *Eli Lilly* case has not been abrogated by the *Sears* and *Compco* rule. The lower courts erred in failing to provide warning-label relief in the present case.

There was also considerable evidence of actual confusion between plaintiff's trade symbols K-4, K-5, K-11 and K-12 and the marks C-4, C-55, C-11 and C-12 of Carolite. Misdirected orders (Plf. Exs. 48, 75-77, 81-83) and testimony as to confusion (R. 919-20; Glass Dep'n., pp. 15-16) was received by the court. No confusing similarity was found; nor was the mark CAROLITE found to infringe the registered trademark K-LITE. Again the lower courts failed to consider the exacerbated likelihood of confusion caused by Carolite's use of these marks and identical marketing methods on identical products. Since a customer could not distinguish Carolite unlabeled panels from those of plaintiff after the sale, it was incumbent upon Carolite to prevent confusion beforehand by adopting dissimilar trade symbols. The lower courts in this case, as in other cases involving the *Sears* and *Compco* rule, have been more lenient in passing upon marketing practices of a copier than on non-competitors. See, *Kingsway Inc.* v. *Werner*, 233 F.Supp. 102 (E.D. Mo. 1964). The result is the protection of a selected sphere of consumer interest—free competition—at the sacrifice of interests that are equally important—purchaser confusion and protection.

The cases interpreting this Court's decision in the *Sears* and *Compco* cases demonstrate that there is uncertainty as to the scope of permissible prohibition of unfair marketing practices. And though relief such as labeling is generally agreed upon as an allowable sanction, it is also recognized as inadequate in many circumstances. *Spangler Candy Company* v. *Crystal Pure Candy Company*, 353 F.2d 641, 648 (7th Cir. 1965). Secondary meaning is required in some cases but not in others. Intent to deceive is critical to one court and ignored by others.

This case provides an opportunity for a further exposition of the limits of state power in prohibiting unfair marketing of copied articles. The law following the *Sears* and *Compco* cases has become indefinite and uncertain. If a course can be discerned, it is toward *less protection of the purchaser* against a manufacturer which is not satisfied with copying the product but must also appropriate the goodwill of its competitor's reputation to the probable damage of the ultimate purchaser.

Finally, it is submitted that the lower courts were in error in holding that at least two of Plaintiff's trade symbols were generic. The terms K-11 and K-12 were used exclusively by Plaintiff from January and October 1963, respectively, a period of two years prior to this lawsuit, to identify its lighting panels. (Findings of Fact Nos. 8 and 9, *K-S-H* v. *Sunbeam*, No. 22049A) Prior to this adoption by Plaintiff, the symbols K-11 and K-12 were unknown in the industry and were entirely arbitrary. Defendants attempted to show that these marks were known as pattern designations, but the evidence showed only that the symbols served only secondarily to indicate a pattern. And the law clearly provides that a symbol which identifies source and additionally pattern or grade

does not thereby lose its character as a trademark. *Menendez* v. *Holt*, 128 U.S. 514 (1888).

The Court of Appeals was legally in error in stating that "[t]he evidence is sufficient to show that while the 'K' usage may have been peculiar to K-S-H, the overall trade use of *similar* numbers was such that the K-numbers cannot be said primarily to designate origin." (Emphasis added). Only Carolite used similar symbols, C-11 and C-12, to identify its panels having the same configuration. Such use did not show that the symbols were generic; instead, it showed an attempt to appropriate the goodwill of Plaintiff which inhered in its trade symbols. To follow the lower courts' logic is to make a legal finding that future products of Plaintiff with similar K numbers are generic the day they are used. Defendants failed to prove that these symbols were generic and the lower courts erred in so holding.

Conclusion

This case presents substantial and important questions concerning the scope of protection permitted by state law to prevent confusion of purchasers by a manufacturer of copied articles. Certiorari should be granted.

Respectfully submitted,

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APPENDIX

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

K-S-H PLASTICS, INC., a Missouri corporation, *Appellant*, vs. CAROLITE, INC., a California corporation and J. W. CARROLL & SONS, a California corporation, *Appellees.*	No. 22,049
K-S-H PLASTICS, INC., a Missouri corporation, *Appellant*, vs. SUNBEAM LIGHTING COMPANY, INC., a California corporation, *Appellee.*	No. 22,049-A

[February 26, 1969]

Appeal from the United States District Court for the Central District of California

Before: DUNIWAY, ELY and HUFSTEDLER, Circuit Judges

DUNIWAY, Circuit Judge:

The plaintiff below, K-S-H Plastics, Inc., appeals from judgments entered in two companion cases involving trademark and unfair competition questions. The cases were tried together, but the trial judge made separate findings and entered a separate judgment in each case. K-S-H sought injunctions against the use by defendant Carolite, Inc.,[1] of certain of its trademarks and trade symbols, and against the palming off of Carolite's products

[1]Defendant J. W. Carroll & Sons is a related corporation which apparently is no longer engaged in the activities complained of. Thus, the opinion will refer only to Carolite, Inc. as the defendant in No. 22,049.

as those of K-S-H by defendants Carolite and Sunbeam Lighting Co., Inc. The district court found for defendants regarding the trademark and trade symbol claims and granted narrowly restricted relief on one palming-off claim. We affirm.

Jurisdiction in the Sunbeam case is founded on diversity. 28 U.S.C. § 1332. Jurisdiction in the Carolite case rests on 28 U.S.C. § 1338 as read with 15 U.S.C. § 1121 (trademark and joined unfair competition claims). See *Ross-Whitney Corp. v. Smith Kline & French Laboratories,* 9 Cir., 1953, 207 F.2d 190.

K-S-H manufactures plastic lighting panels, as does Carolite. Sunbeam makes lighting fixtures which use the plastic panels as a component part.

The manufacturers of plastic lighting panels are a part of the building construction industry. A number of manufacturers like K-S-H and Carolite supply lighting panels to a channel of trade which includes the fixture manufacturer, electrical contractor, general contractor, and building owner. Architects or lighting engineers, as agents for building owners, prepare specifications identifying the electrical equipment, including lighting fixtures and the lighting panels to be used with the fixtures. Lighting fixture manufacturers then prepare bids from the specifications. Based on these bids, the owner awards the contract to a general contractor or an electrical equipment contractor. In either case, a purchase order will be placed with an electrical equipment distributor. The distributor orders the fixtures from the lighting fixture manufacturers. The fixture manufacturers order the panels from suppliers like K-S-H or Carolite. If the lighting panel is specified to be that of a particular lighting panel manufacturer, the panel is ordered from that manufacturer, or approval is obtained by the fixture manufacturer for a substitute panel; otherwise the fixture manufacturer will buy the panel from any panel manufacturer that makes it.

This case primarily involves questions of confusion over the designation of panels on the part of lighting engineers and fixture manufacturers, and of palming off one panel manufacturer's products for those of another.

I. *The Manufacturers' Trademarks*

K-S-H claims that Carolite has infringed its registered trademark "K-LITE" by use of the latter's registered trademark "CARO-

LITE." In its Finding No. 15, in case No. 22,049, the trial court found that: "The term CAROLITE is not confusingly similar to the mark K-LITE; the plaintiff has shown no actual confusion or a likelihood of confusion, mistake or deceit by reason of the use of the terms in connection with similar goods."

The question is whether Carolite's use of the trademark CAROLITE "is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services." *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 9 Cir., 1963, 314 F.2d 149, 151-152. This test requires consideration of a number of factors, including the visual, verbal, and intellective similarity of the marks, *Sleeper Lounge Co. v. Bell Mfg. Co.*, 9 Cir., 1958, 253 F.2d 720, the class of goods to which the marks are applied, *Fleischmann Distilling Corp. v. Maier Brewing Co., supra,* the marketing channels through which the goods are sold, *Durox Co. v. Duron Paint Mfg. Co.*, 4 Cir., 1963, 320 F.2d 882, and the intent of defendant in adopting the mark. *Fleischmann Distilling Corp. v. Maier Brewing Co., supra.*

Here the marks are somewhat similar—both use the suffix "lite." but "Kay" (for K) and "Caro" are quite different. The marks apply to goods purchased by fixture manufacturers and designated by architects or lighting engineers who deal with the products continuously and with a fair degree of sophistication. K-S-H argues that the logotype used with the mark CAROLITE adds to the confusion. The letters "caro" are placed within a large "C" to give the following appearance:

Nonetheless, in light of the market and the purchasers, the "K" is sufficiently distinguishable from the "

". Further, no wrongful intent may be imputed to Carolite through the use of the suffix "lite," as this suffix commonly is used in lighting industry marks. Evidence as to wrongful intent on Carolite's part is, at the

most, conflicting. The trial court correctly held that the mark CAROLITE does not infringe the mark K-LITE.

II. *The Alphanumeric Symobls*

K-S-H designates its panel types by "alphanumeric" symbols, *i.e.*, combinations of letters and numbers, or "K-numbers," *e.g.*, K-4, K-5, K-11, and K-12. Carolite employs a similar system of letters and numbers for its panels of identical design, *e.g.*, C-4, C-55, C-11, and C-12. At the time of the filing of the complaint, neither K-S-H nor Carolite had registered its symbols as trademarks.

K-S-H sought to enjoin Carolite from "advertising, selling or in any manner using the product designations or symbols consisting of a capital letter and numbers which are identical or confusingly similar to those used by plaintiff." K-S-H also sought to prevent Sunbeam from passing-off panels made by Carolite or other suppliers when panels were ordered by the K-number designation with or without the terms K-S-H or K-LITE. Sunbeam and Carolite conceded that they had supplied Carolite panels when panels had been specified by K-number alone.

The trial court held that the Carolite C-number designations were not confusingly similar to the K-number pattern designations, and also that K-S-H had not established a secondary meaning of the K-number terms, but that "[t]he primary significance of K-numbers, alone and apart from K-LITE or KSH, both in the trade and among purchasers is one of pattern and not producer." Finding No. 10, in case No. 22,049A. Accordingly, the court refused to enjoin Sunbeam from supplying Carolite or another manufacturer's panels when the order or specification was solely by K-number. It did enjoin Sunbeam from supplying other than K-S-H panels when the order used a K-number in conjunction with the K-S-H or K-LITE, and Carolite from knowingly palming off or knowingly inducing or abetting fixture manufacturers like Sunbeam to palm off Carolite's panels as those of K-S-H when the order used a K-number with the terms K-S-H or K-LITE.

A. *Trademark rights in the symbols*

Since the alphanumeric symbols or K-numbers are not registered marks, any protection must arise from the common law. The parties have debated the common law distinction between technical

and non-technical trademarks, as each seeks a favorable burden of proof allocation. K-S-H contends that the symbols are technical trademarks because they are "fanciful, arbitrary, unique, distinctive, and nondescriptive in character." See 3 R. Callmann, Unfair Competition and Trademarks, § 66.1 (2d ed., 1950). From this K-S-H argues that Carolite had, and has failed to sustain, the burden of proving that the K-numbers had become pattern designations or generic symbols. See *Dresser Industries, Inc. v. Heraeus Englehard Vacuum, Inc.*, 3 Cir., 1968, 395 F.2d 457; *Ross-Whitney Corp. v. Smith Kline & French Laboratories*, 9 Cir., 1953, 207 F.2d 190. Carolite contends that the symbols are not fanciful, etc., and thus not technical marks, and that therefore K-S-H carried, and has failed to sustain, the burden of proving that the symbols had acquired a secondary meaning sufficient to raise them to the status of nontechnical marks. *Everest & Jennings, Inc. v. E & J Manufacturing Co.*, 9 Cir., 1958, 263 F.2d 254, 259-60.

The symbols here are not so distinctive that they are valid *per se* as technical marks and do not require the showing of secondary meaning. Other panel manufacturers use similar alphanumeric designations for their panel configurations. Accordingly, we must examine whether the trial court was clearly erroneous in concluding that the symbols had not acquired a secondary meaning, and did not serve primarily to designate origin. *William H. Keller, Inc. v. Chicago Pneumatic Tool Co.*, 7 Cir., 1923, 298 F. 52, 59. See also *Kellogg Co. v. National Biscuit Co.*, 1938, 305 U.S. 111, 118-119; *Everest & Jennings, Inc. v. E & J Manufacturing Co., supra.*

The evidence indicates that other panel manufacturers used very similar symbols, *e.g.*, P-4, R-4, and that some of them used their symbols before K-S-H began using its K-designations. The evidence is sufficient to show that while the "K" usage may have been peculiar to K-S-H, the overall trade use of similar numbers was such that the K-numbers cannot be said primarily to designate origin.

Further, the trial court's finding that the symbols had become generic terms designating pattern and not producer is fully supported by the evidence. A number of fixture manufacturers testified that K-numbers had become a short-hand industry expression for a given panel configuration. Some fixture manufacturers actu-

ally quoted K-numbers as a part of their catalog alphanumeric designation for certain types of light fixtures.

Under these circumstances, the trial court properly refused to enjoin Carolite's use of "C-numbers."

B. *Palming off*

The tort of palming off by a third party or dealer is defined as the unauthorized substitution of the goods of one manufacturer when the goods of another are requested by the customer. See *Singer Mfg. Co. v. Golden*, 7 Cir., 1948, 117 F.2d 266, 268. The trial court properly enjoined Sunbeam's substitution of panels made by manufacturers other than K-S-H when an order came in for panels designated by K-number in conjunction with the term K-S-H or its trademark K-LITE. But K-S-H is barred from obtaining any further relief by the proof at trial that K-numbers used alone did not primarily indicate origin or that the purchaser specifically wanted K-S-H panels.[2]

III. *The Alleged Overall Carolite Plan to Palm Off Its Products As Those of K-S-H*

Finally, K-S-H alleges that Carolite had adopted a "predatory plan and an intention to confuse and deceive purchasers" by engaging in a series of trade practices, none of which standing alone would be sufficient to prove palming off. The facts upon which K-S-H relies are: (1) adoption of confusingly similar alphanumeric symbols to designate panel types; (2) use of trade catalogs with nearly identical format and testing laboratory performance data; and (3) use of similar marketing methods—*i.e.*, continual introduction of products and product improvements just after K-S-H introduced the identical panel design for its products. K-S-H alleges that Carolite made it impossible for fixture manufacturers and lighting

[2]We do not believe that we have to choose between California or federal law regarding this claim of unfair competition. "[T]he federal and state law is not essentially different; and both federal and state courts have readily borrowed decisions from one another and from the entire body of law in this field . . . . Under the circumstances we shall rely upon the 'indeterminate general law.'" *Hygienic Specialties Co. v. H. G. Salzman, Inc.*, 2 Cir., 1962, 302 F.2d 614, 619 n. 9. Moreover, if California law does control, a question which we need not decide, we are cited to no California authority that would require a reversal here.

engineers to distinguish Carolite products from K-S-H products, particularly when ordering or specifying panels. K-S-H does not assert that Carolite does not have the right to copy its products, nor does it claim any copyright protection in any of its catalogs or marketing materials.

The two cases upon which K-S-H relies, *Midwest Plastics Corp. v. Protective Closures Co.*, 10 Cir., 1960, 285 F.2d 747, and *American Safety Table Co. v. Schreiber*, 2 Cir., 1959, 269 F.2d 255, support the proposition that while a manufacturer can imitate a product, he cannot market it in a way which he knows will induce purchasers to buy it thinking that it is the product of another. See also *Kellogg Co. v. National Biscuit Co.*, 1938, 305 U.S. 111, 119; *William R. Warner & Co. v. Eli Lilly & Co.*, 1924, 265 U.S. 526, 532; *Swank, Inc. v. Anson, Inc.*, 1 Cir., 1952, 196 F.2d 330, 332.

Sears, Roebuck & Co. v. Stiffel Co., 1964, 376 U.S. 225, and *Compco Corp. v. Day-Brite Lighting, Inc.*, 1964, 376 U.S. 234, do not bar this action; they permit the copying of unpatented products, a feature of the cases on which K-S-H does not rely. Its reliance is on identification factors as found in designation and marketing practices.

But notwithstanding the presence of an appropriate theory for recovery, K-S-H has not been able to prove its case. The trial court specifically found that no confusion existed between the K-S-H and Carolite symbols. The catalogs were also standard to the industry, and Carolite's catalog is prominently marked with its name. Carolite's catalog is also gold where the K-S-H catalog is blue-green in color. The testing laboratory used by the firms was the same, but the laboratory is a standard source of testing data for the industry. Many of the panels newly introduced on the market came from patterns produced by the same engraver, but these patterns were available to all manufacturers. In short, the evidence forecloses any conclusion that the trial court's finding is clearly erroneous. *Swank, Inc. v. Anson, Inc., supra*, and *Viavi Co. v. Vimedia Co.*, 8 Cir., 1917, 245 F. 289, are comparable.

We are not convinced that the trial court applied an incorrect legal standard, *i.e.*, that the court erroneously believed that K-S-H's case was concluded "by its recognition of the fact that it neither

claimed nor had any monopoly rights in the articles involved." *Swank, Inc. v. Anson, Inc., supra,* at 332.

IV. *Costs*

In its reply brief in the *Carolite* case, K-S-H contends that the trial judge erroneously refused to award it all of its costs. K-S-H relies on the fact that during the trial the judge indicated that if K-S-H were partially successful, it would award costs to it. As noted earlier, K-S-H was granted some relief. But a judge is not bound by every remark that he makes during the trial and before he actually decides the case. He can change his mind as he goes along.

Rule 54(d), Fed.R.Civ.Proc., provides for an award of costs "as of course to the prevailing party unless the court otherwise directs." We have said that the trial court has a wide discretion in awarding costs and that we are hesitant to say that the discretion has been abused. *A. T. Smith and Sons v. N. P. Van Valkenburgh Co.,* 9 Cir., 1964, 337 F.2d 702. The trial judge's careful consideration here of such factors as the complexity of the case, the extensive discovery made by the parties, and the limited relief granted to K-S-H forestalls our making any finding of abuse of discretion as the court did in *A. T. Smith.*

Affirmed.

Office of the Clerk
United States Court of Appeals for the Ninth Circuit
U. S. Court of Appeals and Post Office Building
7th & Mission Streets, P. O. Box 547
San Francisco, California 94101

FEB 26 1969

RECEIVED
FEB 26 1969
OWEN J. OOMS

Re: No. 22049, K-S-H Plastics, Inc. v. Carolite
No. 22049A, K-S-H Plastics, Inc. v. Sunbeam Lighting Co., Inc.

Dear Sir:

An opinion in the above case was filed today, and pursuant to Rule 36 of the Federal Rules of Appellate Procedure a judgment was entered affirmed, the judgment or order of the court below (or administrative agency).

Pursuant to Rule 41(a) the mandate of this court will issue 21 days after the entry of judgment unless the court enters an order otherwise, or grants a stay of the mandate or a petition for rehearing is filed. If a petition for rehearing is filed and denied, the mandate shall issue 7 days after the entry of the order denying the petition. 15

Very truly yours,

William B. Luck,
Clerk of Court

Office of the Clerk
U. S. Court of Appeals
P. O. Box 547
San Francisco, California 94101

APR 8 1969.

Owen J. Ooms, Esq.
Attorney at Law
One North LaSalle St.
Chicago, Ill 60602

RECEIVED
APR 1969
OWEN J. OOMS

17

Dear Sir:

The Petition for a Rehearing

heretofore filed in case No. 22048 and A - KSH PLASTICE, INC. v. CAROLITE, INC. & J.W. CARROLL & SONS. KSH PLASTICE, ~~INC. v. SUNBEAM LIGHTING CO., INC.~~

was this day denied.

41(a)

Pursuant to Rule ~~XXX~~ and unless stayed by the order of the Court, a certified copy of the judgment of this Court under said Rule will be due to issue on the expiration of ~~five (5)~~ seven (7) days from the date hereof.

Sincerely,

WM. B. LUCK,

Clerk.

FPI-LPC-10-67-SM-3447

Sec. 32(1) (15 U.S.C. 1114(1)). Remedies—Infringement

Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

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FILED
JUN 25 1969
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, [redacted] 1969

No. [redacted] 178

No. 22049

K-S-H PLASTICS, INC.,

Petitioner,

vs.

CAROLITE, INC., and J. W. CARROLL & SONS,

Respondent.

No. 22049A

K-S-H PLASTICS, INC.,

Petitioner,

vs.

SUNBEAM LIGHTING COMPANY, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

BRIEF IN OPPOSITION.

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IN THE

Supreme Court of the United States

October Term, 1968
No. 1462

No. 22049

K-S-H PLASTICS, INC.,

Petitioner,

vs.

CAROLITE, INC., and J. W. CARROLL & SONS,

Respondent.

No. 22049A

K-S-H PLASTICS, INC.,

Petitioner,

vs.

SUNBEAM LIGHTING COMPANY, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

BRIEF IN OPPOSITION.

Questions Presented.

Petitioner has sought to interject, as questions presented in this case, matters which are neither pertinent or relevant to this petition nor supported by the record. Consequently, Respondents reject Petitioner's confused statement of the Questions Presented (Pet. pp. 2-3).*

*The following abbreviations will be used throughout this brief:
Pet. p. ....: The Petition For Writ of Certiorari.
App. p. ....: The Appendix to the Petition For Writ of Certiorari.
Res. App. p. ....: The Appendix to the Brief in Opposition To the Petition for Writ of Certorari.
R. ....: The Transcript of Record.
Rule ....: Rules of the Supreme Court of the United States.
Respondents: Respondent Carolite, Inc., and J. W. Carroll & Sons and Respondent Sunbeam Lighting Co., Inc.

The issues presented by this Petition are:

1. Whether the Court of Appeals erred in holding that the District Court properly found, as questions of fact, that Respondent Carolite, Inc., and J. W. Carroll & Sons (hereinafter referred to collectively as "Respondent Carolite") did not infringe any trademark of the Petitioner, there was no intent to palm off, and no actual confusion nor likelihood of confusion by reason of Respondent Carolite's practices in the marketing of a product identical to the unpatented articles of Petitioner. Such findings were predicated upon due consideration, singularly and *in toto,* of all of the elements of Respondent Carolite's marketing practices complained of by Petitioner.

2. Whether the lower courts erred in finding, as a question of fact, that the primary significance of the designations K-4, K-5, K-11 and K-12 to purchasers and prospective purchasers of prismatic lighting panels and those in the lighting industry is to designate the pattern configuration of such panels and not to designate a panel specifically manufactured by Petitioner, and that, accordingly, such designations are not entitled to trademark status.

Citations to Opinion Below.

The Findings of Fact and Conclusions of Law of the District Court, not having been appended to the Petition (Rule 23) are appended hereto for the convenience of the Court. (Res. App. pp. 1a-9a, *K-S-H Plastics, Inc. v. Carolite, Inc.,* Case No. 22049; Res. App. pp. 10a-16a, *K-S-H Plastics Inc. v. Sunbeam Lighting, Co., Inc.,* Case No. 22049A)

Supplemental Statement of the Case.

Petitioner's statement of the case is factually accurate through page 3 of the Petition. It should be noted, however, in order to place the facts as stated by Petitioner in their proper context, that Petitioner and Respondent Carolite are but two of many manufacturers of prismatic lighting panels. The panels and the various patterns thereof are not patented nor copyrighted. Many patterns of such panels are common to most of such manufacturers. Other patterns are commonly used by different ones of such manufacturers. Petitioner and Respondent Carolite use alphanumeric designations for the various patterns in their lines of prismatic panels as stated by Petitioner in the third paragraph of the Statement (Pet. p. 4). Other competitors in the industry likewise use alphanumeric pattern designations, as for example, R-4, R-5, S-55, B-70, P-8, P-4, S-4, SL-56 and the like (R. 261-265). Some of such pattern designations for the same pattern produced by different companies have common numerical portions and some do not.

The remainder of Petitioner's Statement of the Case includes "facts" either not supported by the record or contrary to the facts as found by the District Court and the Court of Appeals. Although Respondents do not wish to argue again the facts of the case, Respondents feel constrained by reason of the Petition to comment upon such "facts" or allegations of fact made by Petitioner. For example, the apparently hypothetical statement contained in the Petition at page 4 to the effect that when a lighting lens panel manufactured by K-S-H is specified, an identical panel "may be obtained" by the fixture manufacturer, Respondent Sunbeam Lighting Co.,

Inc. (hereinafter referred to as "Respondent Sunbeam"), from Respondent Carolite, and substituted for the specified panel, is misleading in the context of Petitioner's Statement. It is in such a situation that the District Court did grant relief to Petitioner. Neither this situation, nor the injunctive relief granted, were the subject of the appeal to the Circuit Court of Appeals. The District Court held that

> "Plaintiff [Petitioner] is entitled to a permanent injunction against defendant [Respondent Sunbeam] preventing defendant from unfair competition by palming off and specifically preventing the substitution of lighting panels manufactured by others for those of plaintiff when plaintiff's lighting panels are specified or ordered by K-number in conjunction with K-S-H or K-LITE." (Conclusion of Law No. 7, Res. App. pp. 15a-16a), and, "When an order to Carolite, Inc., of J. W. Carroll & Sons calls for K-LITE, or for K-S-H K-4. K-S-H K-5, K-S-H K-11 or K-S-H K-12, etc., defendants, Carolite, Inc. or J. W. Carroll & Sons, cannot substitute other materials without approval. Such substitution would be unfair competition." (Conclusion of Law No. V, Res. App. p. 9a)

The District Court and Circuit Court of Appeals found, however, that based upon the evidence presented at the trial, an order or specification designating the panel by K-numbers alone without reference to K-S-H or K-LITE (the trademark of K-S-H) was considered in the industry to be an order for a particular pattern of panel only and not an order for a panel from a particular source. (Findings of Fact No.

4 and 10, Res. App. pp. 10a-11a, 13a-14a; Finding of Fact No. 17, Res. App. pp. 6a-7a; and App. p. 5a)

The further allegations of fact set out in Petitioner's Statement were all considered and decided by both the District Court and Circuit Court of Appeals. There is no support in the record for Petitioner's italicized comment in the Statement (Pet. p. 4) that the embossing tools manufactured by the engraver who served the industry were made from Petitioner's specifications and drawings and at its cost. The evidence and findings (App. p. 7a) were to the effect that the patterns produced by the engraving company were available to all manufacturers. With respect to the photometric test reports from the same testing laboratory, the lower courts found (App. p. 7a) that the laboratory was a standard source of testing data for the industry. Further, both the District Court and Circuit Court of Appeals compared the catalogs of Petitioner and Respondent Carolite and determined that the catalogs are also standard to the industry and not confusingly similar. (App. p. 7a)

Thus, although Petitioner again attempts in its Statement to draw similarities between certain of Petitioner's and Respondent Carolite's marketing practices, the extensive evidence concerning such practices has been fully considered by the District Court and Circuit Court of Appeals. As a result of such consideration, both courts determined that Respondent Carolite's marketing practices did not cause confusion, nor a likelihood of confusion, nor did they show an intent to palm off.

Reasons for Denying Writ.

Petitioner has not stated specifically the reasons it relies upon for seeking review. Review by Writ of Certiorari is a matter of sound discretion which will be granted only where there are "special and important reasons." (Rule 19) No special and important reason is presented by Petitioner. Further, Rule 19(1)(b) enumerates the character of reasons which will be considered by this Court for granting review on Writ of Certiorari from a Circuit Court of Appeals and none of the reasons recited therein are present in the instant petition.

Despite Petitioner's multiple alleged "reasons" for review, it seems apparent that the District Court's Findings of Fact to the effect that there was no infringement of Petitioner's trademark by Respondent Carolite no intent to palm off, and no confusion by reason of the marketing practices of Respondent Carolite and the affirmance of those Findings of Fact by the Circuit Court of Appeals are the primary issues in this case.

A secondary issue is whether the lower courts were correct in their determination as a question of fact that, based upon the evidence presented, the alpha-numeric designations were primarily indicative of pattern and not of origin or source.

The Writ of Certiorari should be denied because:

1. *The concurrent findings of fact by the two courts below are not in error.* The issues of Trademark Infringement and Unfair Competition were determined as questions of fact based on evidence which foreclosed any conclusion that the District Court's findings were clearly erroneous. The only issues now before this Court

are the same factual determinations already considered in depth and decided by the two lower courts. The factual determinations as stated in the District Court's Findings of Facts and as found by the Circuit Court of Appeals are adequately supported by the evidence presented and, therefore, are not "clearly erroneous".

2. *There are no special or important reasons for granting a Writ of Certiorari.* Regardless of the quantum of duty urged by Petitioner to be placed upon Respondent as manufacturers and seller of similar goods to those of Petitioner, such duty was found factually to have been met by Respondent in the present case. That is, Respondent Carolite practices avoided any likelihood of confusion as to source.

3. *There is no conflict of decisions.* There is no conflict beween the judgments below and the decisions by this Court in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting Inc.*, 376 U.S. 234 (1964) (hereinafter referred to as *"Sears"* and *"Compco"*, respectively), or in any of the decisions by circuit courts of appeal cited by Petitioner. The decisions by the lower courts in the instant case follow this Court's decrees in the *Sears* and *Compco* cases and properly apply the applicable laws of unfair competition to the facts of the case.

ARGUMENT.

1. The Issues of Trademark Infringement and Unfair Competition Were Determined as Questions of Fact Based on Evidence Which Foreclosed Any Conclusion That the District Court's Finding Was Clearly Erroneous.

(a) The Theory of Petitioner Is Not Supported by the Facts of the Case.

Petitioner, throughout the District Court and Circuit Court of Appeals actions, has advanced a theory which it has chosen to call a "predatory plan" theory. Whether such theory does or does not have merit is immaterial in a consideration of the Petition since the Circuit Court of Appeals found that in the instant case, "[n]otwithstanding the presence of an appropriate theory for recovery, K-S-H [Petitioner] has not been able to prove its case." (App. p. 7a). Petitioner is still attempting to promulgate its theory and, in doing so, is arguing only with findings of fact determined by the District Court and found by the Court of Appeals to be amply supported by the evidence. Petitioner's theory of a predatory plan rests upon trademark infringement of Petitioner's registered trademark "K-LITE" and valid trademarks in the alphanumeric designations, K-4, K-5, K-11 and K-12, together with additional elements in Respondent Carolite's "mode of doing business" which are alleged to be confusingly similar to Petitioner's marketing practices. The lower courts have found otherwise. Those aspects of Respondent Carolite's marketing practices as to which Petitioner has continually complained and still asserts to be confusingly similar to Petitioner's practices are the similarity of catalogs, the use of the same testing laboratories and

their laboratory reports, the use of the same engraver and, finally, the use of C C-55, C-11 and C-12 compared to K-4, K-5, K-11 a K-12 of Petitioner as pattern designations. That such practices, whether considered alone or in combination, do not constitute unfair competition was decided by the lower courts as set out necessarily, due to the thrust of the petition, in some detail below.

(b) There Is No Infringement of Petitioner's Registered Trademark K-LITE by Respondent Carolite's Use of the Trademark CAROLITE.

The statute cited by Petitioner as the statute involved in this action is Sec. 32(1) of the Lanham Act, 15 U.S.C. §1114(1) (1962) dealing with infringement of a federally registered trademark. It was upon the basis of an allegation by Petitioner of trademark infringement of Petitioner's registered mark by Respondent Carolite that federal jurisdiction was based. (R. 2, 4)

In determining whether or not trademark infringement exists, the courts have considered a number of factors. Most important among such factors are: the phonetic and visual impression of the words, *Sleeper Lounge Co. v. Bell Mfg. Co.*, 253 F. 2d 720 (9th Cir. 1958); the class of goods to which the marks are applied, *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963); the marketing channels through which the goods are sold, *Durox Co. v. Duron Paint Mfg. Co.*, 320 F. 2d 882 (4th Cir. 1963), and the intention of the alleged infringer in adopting the mark, *Family Circle, Inc. v. Family Circle Associates, Inc.*, 332 F. 2d 534 (3rd Cir. 1964); *Squirrel Brand Co. v. Barnard Nut Co.*, 224 F. 2d 840 (5th Cir. 1955), *cert. denied*, 350 U.S. 995 (1956).

Both the District Court and Circuit Court of Appeals considered the above factors. The Circuit Court of Appeals affirmed that, "The trial court correctly held that the mark CAROLITE does not infringe the mark K-LITE." (App. p. 4a)

(c) There Is No Actual Confusion nor Likelihood of Confusion by Reason of Respondent Carolite's Marketing Practices.

The District Court considered and compared the catalogs, the facts concerning the testing laboratories and engravers, and the alphanumeric designations of Petitioner and Respondent Carolite and found that:

> "The pattern designations C-4, C-55, C-11 and C-12 are not confusingly similar to the pattern designations K-4, K-5, K-11 and K-12; the plaintiff [Petitioner] has not shown that there is actual confusion or a likelihood of confusion, mistake or deceit by reason of the use of the designations in connection with similar products. The term CAROLITE is not confusingly similar to the mark K-LITE; the plaintiff has shown no actual confusion or a likelihood of confusion, mistake, or deceit by reason of the use of the terms in connection with similar goods. The designations, 'C-numbers' and CAROLITE, of defendants [Respondent Carolite] are not visually nor phonetically similar to those of plaintiff and to the extent of any similarity are descriptive. The use of tools from the same engraver as plaintiff, 'C-numbers,' patterns substantially identical to plaintiff, and the same testing laboratory as plaintiff, does not create any confusion or likelihood of confusion nor does it

show any intent to palm off. The defendants, Carolite, Inc. and J. W. Carroll & Sons, display their name on their cards, stationery, order forms, invoices, packing slips and cartons in which all products are shipped. The catalogs and test reports of defendants are clearly marked with their names. The usual way of ordering panels is to telephone the order into Carolite and then confirm by written order. The customers of plaintiff and defendants are sophisticated buyers." (Finding of Fact. No. 15, Res. App. pp. 5a-6a)

The Circuit Court of Appeals again considered the facts underlying and in support of Petitioner's theory of unfair competition and found that:

> "[N]otwithstanding the presence of an appropriate theory for recovery, K-S-H [Petitioner] has not been able to prove its case." (App. p. 7a)

After a discussion of each of the complained of practices of Respondent Carolite, the court concluded:

> "In short, the evidence forecloses any conclusion that the trial court's finding is clearly erroneous. *Swank, Inc. v. Anson, Inc., supra,* [196 F. 2d 330 (1st Cir.-1952)] and *Viavi Co. v. Vimedia Co.*, 8 Cir., 1917, 245 F. 289 are comparable." (App. p. 7a)

(d) The Alphanumeric Designations K-4, K-5, K-11 and K-12 of Petitioner Were Found Not to Be Trademarks and the Designations C-4, C-55, C-11 and C-12 Were Found Not to Be Confusingly Similar Thereto.

Contrary to the argument of Petitioner, the lower courts did consider the likelihood of confusion by reason of the conglomerate of all of the elements com-

plained of by Petitioner including, specifically, the status of the alphanumeric designations in connection with the similar goods. (Finding of Fact No. 15, Res. App. pp. 5a-6a)

The lower courts considered an abundance of evidence concerning the status of the alphanumeric designations K-4, K-5, K-11 and K-12 (R. 854-857, 904-1020) including the manner in which Petitioner, as well as the buyers of the products and others in the industry, employed and regarded the designations. (Findings of Fact No. 9 and 10, Res. App. pp. 13a-14a) The District Court found that:

> "The primary significance of K- numbers alone and apart from K-LITE or K-S-H, both in the trade and among purchasers is one of pattern and not producer." (Finding of Fact No. 10, Res. App. pp. 13a-14a)

The Circuit Court of Appeals affirmed and found that:

> "The evidence indicates that other panel manufacturers used very similar symbols, *e.g.*, P-4, R-4, and that some of them used their symbols before K-S-H began using its K-designations. The evidence is sufficient to show that while the "K" usage may have been peculiar to K-S-H, the overall trade use of similar numbers was such that the K-numbers cannot be said primarily to designate origin." (App. p. 5a)

Petitioner has stated in its argument that there was evidence of actual confusion between Petitioner's K-numbers and Respondent Carolite's C-number pattern designations and that there were misdirected orders and

testimony as to confusion. Again, Petitioner is apparently quarrelling with the findings of fact in order to advance a theory. The District Court found contrary to the above statements (Finding of Fact No. 10, Res. App. pp. 13a-14a) and the Circuit Court of Appeals affirmed.

Reference by Petitioner to misdirected orders and confusion can be made only by complete disregard of both lower court findings that the K-numbers designated the pattern of the panel in such orders. Considerable evidence was introduced and reviewed and in all cases where testimony was received with respect to such orders, the buyer stated it received the panel from the manufacturer from which it intended to buy. (Finding of Fact No. 12, Res. App. p. 14a)

Further, and most importantly, not a single instance of customer confusion or palming off was shown in which a customer ordered a panel by K-number alone and received it other than from the manufacturer from which it intended to purchase (Finding of Fact No. 12, Res. App. p. 14a)

In determining the status of the alphanumeric designations, the lower courts properly applied the facts to the law to the effect that the marks are not so distinctive that they are valid per se as technical marks and do not require a showing of secondary meaning. *William H. Keller, Inc. v. Chicago Pneumatic Tool Co.*, 298 Fed. 52 (7th Cir. 1923); *Everest & Jennings, Inc. v. E & J Mfg. Co.*, 263 F. 2d 254 (9th Cir. 1958)

(e) The Issues in This Case Were Resolved by Findings of Fact With Which the Petitioner Takes Issue.

That this Court should not review such findings is abundantly clear from its decisions.

This Court has often stated that it cannot and will not undertake to review concurrent findings of fact by two courts below in the absence of very obvious and exceptional showings of error. *Kalman J. Berengi v. District Director, Immigration and Naturalization Service,* 385 U.S. 630 (1967); *Goodyear Tire & Rubber Co. v. Ray-O-Vac,* 321 U.S. 275 (1944); *Williams Mfg. Co. v. United Shoe Machinery Corp.,* 316 U.S. 364 (1942); *Charles H. Baker v. John W. Schofield,* 243 U.S. 114 (1914). This Court is basically a court of law rather than a court for reviewing findings of fact by lower courts which are clearly supported by substantial evidence to determine whether it would have also made the same factual findings on the evidence presented. *Graver Tank and Mfg. Co. v. Linde Air Products Co.,* 336 U.S. 271 (1949). This Court has stated that it has no empirical expertise to set aside careful and reasonable conclusions of lower courts on purely factual issues which turn largely on the assessments of the relative credibility of witnesses whose testimonial demeanor was observed only by the trial court. *Kalman J. Berengi v. District Director, Immigration and Naturalization Service, supra.*

2. There Are No Special or Important Reasons for Granting a Writ of Certiorari.

Contrary to Petitioner's mere conclusion (Pet. p. 12), the instant case presents no "substantial and important questions" for the protection of the purchasing pub-

lic. The courts below recognized and carefully considered Petitioner's rights and the public's interest against deception under the trademark laws and under the laws of unfair competition. The courts found that the activities of Respondent Carolite, allegedly intended to confuse and deceive purchasers, were not proven. In fact, the lower courts found that, for the most part, the activities of Respondent Carolite complained of by Petitioner as a "predatory plan" were shown by the great weight of evidence to be standard practices or procedures in the industry and there was no resulting confusion to purchasers. This is hardly the type of case that presents "special and important reasons" (Rule 19) for granting review by a Writ of Certiorari. Regardless of the quantum of duty urged by Petitioner to be placed upon Respondent Carolite as a manufacturer of similar goods to those of Petitioner, such duty was found to have been fully met in the present case and no likelihood of confusion to the purchasers as to source was proven. The "special and important reasons" recited in Rule 19 relating to the granting of Certiorari deal with problems beyond the academic or episodic. *Rice v. Sioux City Memorial Park Cemetery,* 349 U.S. 70 (1955). Petitioner cannot elevate the basic issues of the present case to the stature generally required to obtain review in this Court by Writ of Certiorari by a mere conclusionary statement.

3. There Is No Conflict Between the Judgments Below and the Decisions by This Court or the Various Circuit Courts of Appeal in the Decisions Cited by Petitioner.

The decision in the instant case is in direct harmony with the rule of this Court as set out in the *Scars* and

Compco cases, as quoted by Petitioner. (Pet. p. 6) The Circuit Court of Appeals in the instant case has applied the California or Ninth Circuit statutory and decisional law of unfair competition. (App. p. 6a)

The Circuit Court of Appeals for the Second Circuit, in the case of *Flexitized, Inc. v. National Flexitized Corp.*, 335 F. 2d 774, 783 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965), cited by Petitioner and said by Petitioner to be one of the examples of disparate views as to the Courts' obligations flowing from the *Sears* and *Compco* rule, commented:

> " 'What is true of all actions, is especially true in a suit for unfair competition: disposition of each case peculiarly depends upon the precise state of the facts disclosed.' [Citations Omitted]"

It is upon this basis that the instant case is not inconsistent with, nor contradictory to, any of the cases cited by Petitioner nor with the rule of the *Sears* and *Compco* cases. The lower courts have decided the instant case on precisely the bases of the mandate of, and allowable discretion afforded to them by, this Court in the *Sears* and *Compco* cases.

Whether or not the circuit courts and district courts have applied varying degrees of stringency and imposed varying quanta of burden on competitors selling visually similar goods is immaterial to this petition since the lower courts have found, based upon the facts of this case, that no palming off, actual confusion or likelihood of confusion exists by reason of the various aspects of Respondent Carolite's marketing practices.

Based upon the state of facts disclosed in *Tappan Co. v. General Motors Corp.*, 380 F. 2d 888 (6th Cir.

1967), the District Court and Circuit Court of Appeals for the 6th Circuit found no unfair competition by marketing a simulated product on the basis that no buyer could be confused as to the source of the merchandise and no intent to deceive could be imputed to the manufacturer.

The cases of *Bentley v. Sunset House Distributing Corp.*, 359 F. 2d 140 (9th Cir. 1966), and *Plastics Research & Development Corp. v. Norman*, 243 Ark. 780, 422 S.W. 2d 121 (1967), were again decided upon their peculiar facts but consistently with the instant case and the rule of the *Sears* and *Compco* cases. In *Bentley v. Sunset House Distributing Corp., supra* at p. 146, no palming off was found by the Ninth Circuit Court of Appeals, which stated that:

> "[T]he law of unfair competition does not prevent the copying of non-patentable articles unless the public is misled as to the source of those articles. [citing *Sears* and *Compco*]. Here the public could not have been misled."

In *Spangler Candy Co. v. Crystal Pure Candy Co.*, 353 F. 2d 641 (7th Cir. 1965), the seventh circuit, from whence the *Sears* and *Compco* cases originated, apparently felt constrained to impose a non-stringent criteria upon a competitor; but, again, such decision was based upon findings that the dress of the goods had not acquired secondary meaning and that there was no palming off.

The various reasons of alleged confusion of the district courts as set out by Petitioner (Pet. p. 8) are not relevant to the decision in this case and no confusion as to the law to be applied to the facts exists in the instant case.

The present decision is also consistent with Petitioner's own comment on the case of *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 615 (1924), about which Petitioner says that, "In effect, this Court recognized that a copier's marketing practices must be particularly circumspect." (Pet. p. 9) Assuming *arguendo* that inasmuch as Respondent Carolite's prismatic panels were visually indistinguishable from those of Petitioner and that it is therefore a copier of products, it is clear from the findings of fact made by the District Court and the Ninth Circuit affirmance of those findings of fact after independent consideration of the evidence, that Respondent Carolite's actions in this case were indeed circumspect and that there was no predatory plan which could lead to a finding of unfair competition under any of the cases cited by Petitioner or under the *Sears* and *Compco* cases. In each of the cited cases the Court made reference to the fact that it was clear that the various states could have suitable labelling laws and that in each instance no such labelling law was in effect in any of the Second, Seventh or Ninth Circuits. Petitioner apparently is not concerned merely with the decision in the present case but is an advocate of some form of federal labelling law.

In the instant case, the Circuit Court of Appeals did not preclude Petitioner from recovery for unfair competition based upon the *Sears* and *Compco* cases or upon any non-stringent or defined quanta of duty. To the contrary, the court held that Petitioner was not precluded, but that notwithstanding an appropriate theory, the facts were inconsistent with Petitioner's contentions and that it had not proved its case.

Conclusion.

Petitioner does not specifically or impliedly advance any grounds under Rule 19, or otherwise, for consideration by this Court for the granting of Certiorari.

Respondents respectfully submit that this case presents no important question of federal law. The issues raised by the Petition are whether the District Court properly made determinations of fact, that there was no unfair competition or trademark infringement by Respondents.

Respectfully submitted,

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RESPONDENTS' APPENDIX.

Defendants', Carolite, Inc. and J. W. Carroll & Sons, Modified Findings of Fact and Conclusions of Law.

Lodged Apr. 24, 1967.

Filed May 4, 1967.

United States District Court, Central District California.

K-S-H Plastics, Inc., a Missouri corporation, Plaintiff, vs. Carolite, Inc., a California Corporation, and J. W. Carroll & Sons, a California Corporation, Defendants. Civil Action No. 65-1238-HW.

The above-entitled cause having come on regularly for trial and the Court having duly considered the evidence and the post trial briefs filed by the parties, and being fully advised in the premises, on the whole record now makes the following:

Findings of Fact

1. Plaintiff, K-S-H Plastics, Inc., is a corporation incorporated under the laws of the State of Missouri, having its principal place of business at Kirkwood, Missouri.

2. Defendant, Carolite, Inc., is a corporation incorporated under the laws of the State of California, having its principal place of business at Wilmington, California.

3. Defendant, J. W. Carroll & Sons, is a corporation incorporated under the laws of the State of California, having its principal place of business at Wilmington, California.

4. Plaintiff began to manufacture plastic prismatic lighting panels in 1958 and has continued to make and sell such panels throughout the United States for the last eight years.

5. Defendant, J. W. Carroll & Sons, has manufactured and sold plastic prismatic lighting panels from April, 1963, until defendant, Carolite, Inc., assumed the manufacture and sale of plastic prismatic lighting panels in approximately August, 1964.

6. The plastic prismatic lighting panels made and sold by the parties are sold to the same class of customers and through the same channels of distribution.

7. The term "plastic prismatic lighting panels" is used to identify lighting panels which are flat sheet panels adapted for use with fluorescent lighting fixtures and having a precise geometric pattern embossed thereon for engineered refraction or control of rays generated from fluorescent bulbs. Such panels are distinguished in the trade from plastic "shapes" which are of various three-dimensional configurations. Flat sheet prismatic lighting panels are often referred to as "lenses."

8. Lighting panels are distributed to the trade in the following manner:

Specifiers (architects or lighting engineers) as agents for the building owners, prepare a specification identifying the electrical equipment, including lighting fixtures, and the lighting panels to be used therewith, in a specification which is distributed ultimately to lighting fixture manufacturers. Bids are prepared by the lighting fixture manufacturers and submitted to the specifiers for approval. Items which are intended

to be provided which are not in accordance with the specification may be submitted by the lighting fixture manufacturer for approval of such substitute by the specifier. Based on these bids, the specifier or owner awards the contract to a general contractor or an electrical equipment distributor. In the event that the lighting panel is specified to be that of a particular lighting panel manufacturer, the panel is ordered from the lighting panel manufacturer, such as plaintiff or defendants, or approval is obtained by the fixture manufacturer for the substitution of a panel from another panel manufacturer. Lighting panels are supplied to fixture manufacturers by defendants and plaintiff in cartons with their respective names thereon. The plaintiff, in addition, imprints its name in the corner of the panel with transparent letters about ¼ inch in height. Some fixture manufacturers, in fitting the panel to the fixture, trim it therefrom. The panels are placed in the fixtures by the fixture manufacturers and shipped to the job site. The plaintiff's transparent printing that remains on the panel is obscured by the fixture.

9. On or about June 30, 1958, plaintiff adopted and began to use the trademark K-LITE on, and in connection with, the sale of a line of its specification quality plastic prismatic lighting panels. The plaintiff has no patent or exclusive right with respect to its pattern designs or panels.

10. Plaintiff registered the term K-LITE under the Federal Trademark Act of 1946, 15 U.S.C. Sec. 1051, et seq., on the principal register, as Registration No. 687,973, issued November 10, 1959, which registration is presently in full force and effect, and

plaintiff has now acquired incontestable rights in such trademark under the provisions of 15 U.S.C. Sec. 1065.

11. Defendant, J. W. Carroll & Sons, adopted and began to use in April, 1963, the term CAROLITE in connection with the sale of plastic prismatic lighting panels. Defendant, Carolite, Inc., has used since August, 1964, to the present time, the term CAROLITE in connection with the sale of its line of plastic prismatic lighting panels. The term CAROLITE is usually employed in the following logotype form:

CAROLITE

12. Defendant, J. W. Carroll & Sons, registered the term CAROLITE under the Federal Trademark Act of 1946, 15 U.S.C. Sec. 1051, et. seq., on the principal register, as Registration No. 793,855, issued August 10, 1965, which registration is presently in full force and effect.

13. Plaintiff presently manufactures and sells a number of different patterns of plastic prismatic lighting panels. Plaintiff identifies its different plastic prismatic lighting panel patterns with "K-numbers," each pattern bearing a different number preceded by the capital letter "K." The patterns presently manufactured and sold by plaintiff are identified as K-4, K-5, K-11 and K-12, etc. The plastic prismatic lighting panels which are the subject of this action are K-4, K-5, K-11 and K-12. These patterns were first sold as follows:

K-4	About May, 1958
K-5	About March, 1959
K-11	January, 1963
K-12	October, 1963

14. Defendant, J. W. Carroll & Sons, did, and defendant, Carolite, Inc., does manufacture and sell a number of different patterns of plastic prismatic lighting panels. Defendants identify their plastic prismatic lighting panel patterns in their CAROLITE line with "C-numbers." Defendants' CAROLITE line of plastic prismatic lighting panels comprises C-4, C-55, C-11 and C-12 panels. Each of such panels have a pattern which is identical to plaintiff's panels having the similar designation. These panels were first sold in connection with the "C-numbers" and the term CAROLITE as follows:

C-55	April, 1963
C-11	January, 1964
C-12	June, 1964
C-4	December, 1964

The defendant, Carolite, Inc., also manufacturs Sunlux, Metalux, and C-1 patterns. The defendant, J. W. Carroll & Sons, presently manufactures and sells only custom plastic parts and other items which are not in issue in this suit.

15. The pattern designations C-4, C-55, C-11 and C-12 are not confusingly similar to the pattern designations K-4, K-5, K-11 and K-12; the plaintiff has not shown that there is actual confusion or a likelihood of confusion, mistake or deceit by reason of the use of the designations in connection with similar products. The term CAROLITE is not confusingly similar to the mark K-LITE; the plaintiff has shown no actual confusion or a likelihood of confusion, mistake, or deceit by reason of the use of the terms in connection with similar goods. The designations, "C-numbers" and

CAROLITE, of defendants are not visually nor phonetically similar to those of plaintiff and to the extent of any similarity are descriptive. The use of tools from the same engraver as plaintiff, "C-numbers," patterns substantially identical to plaintiff, and the same testing laboratory as plaintiff, does not create any confusion or likelihood of confusion or does it show any intent to palm off. The defendants, Carolite, Inc., and J. W. Carroll & Sons, display their name on their cards, stationery, order forms, invoices, packing slips and cartons in which all products are shipped. The catalogs and test reports of defendants are clearly marked with their names. The usual way of ordering panels is to telephone the order into Carolite and then confirm by written order. The customers of plaintiff and defendants are sophisticated buyers.

16. Specifications prepared by lighting engineers and architects which describe or designate lighting panels with a "K-number" in conjunction with the terms K-S-H or K-LITE are a demand upon the supplier to provide a lighting panel manufactured only by plaintiff, and if a lighting panel manufactured by other than plaintiff is supplied, prior approval must be obtained from the architect or lighting engineer who prepared the specification by the fixture manufacturer.

17. The use of alpha numeric designations (K-4, K-5, K-11, etc.) in specifications and orders without more does not require that a panel from a particular manufacturer be supplied. Many other manufacturers also use alpha numeric pattern designations. The alpha numeric designations used alone and not in conjunction with the terms K-S-H or K-LITE in a specification or used alone but as part of a fixture descrip-

tion in the specification or used alone in an order describes only the desired pattern of a diffuser or panel.

18. At the conclusion of plaintiff's case the defendants made a motion to dismiss which was granted with regard to all matters except the Lincoln Hospital Job. The defendants, Carolite, Inc. and J. W. Carroll & Sons, precluded from introducing evidence other than on the Lincoln Hospital Job.

19. Beginning in 1963, the John C. Lincoln Hospital was designed and constructed in Sunnyslope, Arizona, and the specification for this job was prepared by James H. Evans, a lighting engineer employed by the architectural firm of Varney & Associates.

20. The specification for the Lincoln Hospital Job designated the lighting panels to be supplied with the terms "K-S-H K-4 Flat Acrylic Lens." Sunbeam Lighting Co., Inc., was the fixture manufacturer chosen to supply the lighting fixtures and lighting panels for this job. K-4 lighting panels manufactured by plaintiff were purchased by Sunbeam Lighting Co. Inc., indirectly through defendant, Carolite, Inc., who purchased the K-S-H panels from a third party having such K-S-H panels (defendants did not manufacture a panel with the K-4 pattern at that time) and were supplied to the electrical contractor to be installed in the Lincoln Hospital. Defendants, J. W. Carroll & Sons and Carolite, Inc., had no knowledge of the specification in the Lincoln Hospital Job. Defendant, J. W. Carroll & Sons, supplied custom parts for the Lincoln Hospital Job which parts are not in issue in this suit.

21. Subsequently, lighting panels supplied on the Lincoln Hospital Job were damaged prior to installation and replacement panels were ordered from Sunbeam

Lighting Co., Inc. No approval for a substitute of lighting panels manufactured by other than plaintiff was solicited or obtained. Sunbeam Lighting Co. Inc., ordered C-4 panels from defendant, Carolite, Inc., and directed defendant, Carolite, Inc., to ship such replacement panels directly to the job site. The first order (original) and second order (first replacement) to Carolite, Inc. indicated that the purchases by Sunbeam were for the Lincoln Hospital Job. Defendant, Carolite, Inc., shipped the replacement panels in boxes with the name Carolite imprinted thereon to the Lincoln Hospital Job site.

22. The lighting engineer and electrical contractor on the Lincoln Hospital Job were unaware of the substitution of Carolite C-4 panels for the K-S-H K-4, panels until after the commencement of this suit, at which time it was called to their attention by plaintiff.

The following Conclusions of Law, insofar as they may be considered Findings of Fact, are so found by this Court to be true in all respects. From the foregoing facts the Court concludes:

Conclusions of Law

I

This Court has jurisdiction over the parties and subject matter of this action.

II

K-4, K-5, K-11 etc., standing alone, do not, without more, call for K-LITE or K-S-H plastic panels.

III

The use of terms such as C-4, C-55, C-11, C-12 does not infringe plaintiff's designations K-4, K-5, K-11 or K-12.

IV

The use of the term CAROLITE does not infringe the terms K-LITE or K-S-H.

V

When an order to Carolite, Inc., or J. W. Carroll & Sons calls for K-LITE, or for K-S-H K-4, K-S-H K-5, K-S-H K-11 or K-S-H K-12, etc., defendants, Carolite, Inc. or J. W. Carroll & Sons, cannot substitute other materials without approval. Such substitution would be unfair competition.

VI

Defendant, Carolite, Inc. or J. W. Carroll & Sons, is guilty of unfair competition when Carolite, Inc. or J. W. Carroll & Sons, substitutes a C-4 panel for a K-S-H K-4 panel which was so requested from Carolite, Inc. or J. W. Carroll & Sons.

VII

Defendants, Carolite, Inc. and J. W. Carroll & Sons, have not committed unfair competition by making panels having patterns substantially similar to plaintiff, employing the designations C-4, C-55, C-11 and C-12, putting out a catalog, and employing Roehlen Engraving Works and Independent Testing Laboratories.

VIII

Plaintiff is entitled to nominal damages of FIFTY DOLLARS ($50) from Carolite, Inc. and such costs as the court may tax in connection with this action.

ENTER: Harry C. Westover
United States District Judge

Dated: May 4, 1967.

Findings of Fact and Conclusions of Law.

United States District Court, Central District of California.

K-S-H Plastics, Inc., a Missouri corporation, Plaintiff, v. Sunbeam Lighting Co., Inc., a California corporation, Defendant. Civil Action No. 66-168-HW.

The above-entitled cause having come on regularly for consolidated trial with the case of K-S-H Plastics, Inc. vs. Carolite, Inc. et al. (Civil Action No. 65-1238-HW) and the Court having duly considered the evidence and the post trial briefs filed by the parties, and being fully advised in the premises, on the whole record now makes the following:

Findings of Fact

1. Plaintiff, K-S-H Plastics, Inc., is a corporation incorporated under the laws of the State of Missouri, having its principal place of business at Kirkwood, Missouri.

2. Defendant, Sunbeam Lighting Co., Inc., is a corporation incorporated under the laws of the State of California and has its principal place of business at Los Angeles, California.

3. Plaintiff is a manufacturer of plastic lighting panels and began to make and sell plastic prismatic lighting panels in 1958 and has continued to do so throughout the United States up to and including the present time.

4. Defendant Sunbeam is a manufacturer of lighting fixtures and sells plastic lighting panels with its fixtures. When lighting panels other than defendant's

proprietary panels are specified, Sunbeam purchases these lighting panels from manufacturers such as defendant, Carolite, Inc., or others.

5. Lighting fixtures and lighting panels are distributed by a specification and bid system in which the specifications are prepared by architects or electrical engineers as agents of the building owner. The specification may designate the lighting fixture and the lighting panel to be supplied therewith by the use of the fixture manufacturer's name, trade designation, or catalog symbol, which incorporates the description of the panel normally supplied with the fixture designated. In relatively few instances the specifications on which Sunbeam bids describe the panels separately from the fixture using so-called K-number designations following the description of the fixture, as, for example, "K-5 Acrylic Panels"; in still fewer instances these so-called K-numbers are employed in specifications with the trademark or trade name of the plaintiff as, for example, "KSH K-5 Acrylic Panels." Defendant Sunbeam has admittedly furnished panels of Carolite, Inc. on specifications calling for K-number panels alone and without mention of KSH or K-LITE, and the basic question involved in this case is the primary significance of these K-numbers, whether pattern or source, among purchasers and specifically whether such specifications or orders calling for defendant Sunbeam's fixtures and K-numbered panels to be furnished therewith require the furnishing of the panels of plaintiff in the absence of any KSH or K-LITE designation used with such K-numbers.

6. In 1958, plaintiff adopted and began to use the trademark K-LITE on and in connection with the sale

of a line of its specification quality plastic prismatic lighting panels. The term K-LITE is registered under the Federal Trademark Act of 1946, 15 U.S.C. Sec. 1051, et seq., on the Principal Register, as Registration No. 687,973, issued November 10, 1959, which registration is presently in full force and effect, and plaintiff has now acquired incontestable rights in such term under the provisions of 15 U.S.C. Sec. 1065. Defendant has not contested the validity of such registration nor plaintiff's exclusive rights to use the K-LITE mark.

7. Prior to 1957, plaintiff adopted and began to use the trademark K-S-H on and in connection with the sale of plastic prismatic lighting panels. The term K-S-H was registered under the Federal Trademark Act of 1946, 15 U.S.C. Sec. 1051, et seq., on the Principal Register, as Registration No. 639,495, issued January 8, 1957, which registration is presently in full force and effect, and plaintiff has now acquired incontestable rights in such term under the provisions of 15 U.S.C. Sec. 1065. Defendant has not contested the validity of such registration nor plaintiff's exclusive rights to use the K-S-H mark.

8. It is stipulated that plaintiff presently manufactures and sells a number of different patterns of plastic prismatic lighting panels. Plaintiff identifies its different plastic prismatic lighting panel patterns with "K-numbers", each pattern bearing a different number preceded by the capital letter "K". The plastic prismatic lighting panels which are the subject of this ac-

tion are K-4, K-5, K-11, and K-12. These patterns were first sold by plaintiff as follows:

K-4	About May, 1958
K-5	About March, 1959
K-11	January, 1963
K-12	October, 1963

9. Other manufacturers, such as defendant Carolite, produce panels of similar or identical pattern to plaintiff's K-numbered panels, but plaintiff is the only lighting panel manufacturer using the specific K-numbers, K-4, K-5, K-11, and K-12. Plaintiff has never advertised its products under K-numbers alone and all its advertising and promotional material including catalogs feature the name or trademark K-S-H or K-LITE with the K-numbers serving as an adjunct to identify particular patterns. In plaintiff's advertising purchasers are not instructed to use K-numbers to specify the goods, but are advised to employ the trademark K-LITE. It does not appear that plaintiff itself has generally regarded the K-numbers as an indication of source or used them as such, but has relied on its name and registered trademarks to identify the maker of the goods.

10. K-numbers are regularly and substantially used by other fluorescent fixture manufacturing companies in the promotion and sale of lighting panels of others in a similar or identical pattern to plaintiff's K-numbered panels. They are generally used in specifying, ordering, and supplying panels to indicate the pattern only. Such K-numbers are not associated by specification writers and other purchasers or the trade with a single source or manufacturer. The primary significance of K-numbers, alone and apart from

K-LITE or KSH, both in the trade and among purchasers is one of pattern and not producer.

11. Plaintiff has not established a secondary meaning to the terms K-4, K-5, K-11, and K-12.

12. Plaintiff has failed to establish that any party using K-numbers alone in ordering or specifying defendant's fixtures with prismatic lighting panels was specifically seeking to purchase the lighting panels of plaintiff, or that any such purchaser who was supplied with panels manufactured by a party other than plaintiff was deceived, palmed off, or otherwise failed to obtain what was intended to be purchased.

13. Specifications prepared by electrical engineers and architects which describe or designate lighting panels with a K-number in conjunction with the terms K-S-H or K-LITE are a demand upon the lighting fixture manufacturer to provide a lighting panel manufactured only by plaintiff, and if a lighting panel manufactured by a party other than plaintiff is offered or supplied, prior approval must be obtained from the architect or electrical engineer who prepared the specification.

14. Defendant substituted, without authorization or approval, 305 replacement lighting panels manufactured by Carolite, Inc. which were identical in appearance and structure to the K-S-H K-4 lighting panels demanded by the original specifications for installation in the John C. Lincoln Hospital and actually supplied on the original job. The substitution was not made for the purpose or with the intent of palming off Carolite's goods for those of plaintiff, but resulted from defendant's failure to refer back to the original specification

requiring K-S-H panels in filling the replacement order, and the furnishing of the replacement panels of Carolite on the Lincoln Hospital job was the only instance of unauthorized substitution by Sunbeam which was established at the trial of the action.

Conclusions of Law

1. This Court has jurisdiction over the parties and of this action.

2. Plaintiff does not have an exclusive right to use "K-numbers" in the lighting panel industry.

3. Plaintiff does not have any common law trademark rights in K-4, K-5, K-11, and K-12.

4. Plaintiff's Federally registered trademarks, K-LITE (No. 687,973) and KSH (No. 639,495) are valid and plaintiff has the exclusive right to the use of these terms.

5. Defendant is not guilty of unfair competition by substituting without authorization lighting panels manufactured by others than plaintiff when the specification or purchase order designates the lighting panels to be supplied with a K-number alone and apart from KSH or K-LITE.

6. When specifications call for K-LITE or for K-S-H K-4, K-5, K-11, or K-12, defendant cannot substitute other materials. Such substitution would be unfair competition. Defendant has been guilty of unfair competition in substituting 305 K-4 replacement panels on the Lincoln Hospital job.

7. Plaintiff is entitled to a permanent injunction against defendant preventing defendant from unfair competition by palming off and specifically preventing

the substitution of lighting panels manufactured by others for those of plaintiff when plaintiff's lighting panels are specified or ordered by K-number in conjunction with K-S-H or K-LITE.

8. Plaintiff is entitled to nominal damages of Fifty Dollars and such costs in this action as may be taxed by the Court.

Dated: May 4, 1967.

[illegible]
United States District Judge.